

Practitioner's Docket No. 200-007711-US (PAR)

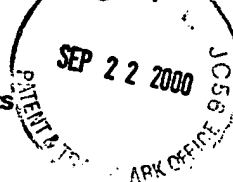
PATENT

SAY 27/05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Seymour, J.
Application No.: 0 8 / 987,995
Filed: 12/10/97
For: PORTABLE ELECTRONIC APPARATUS

Group No.: 2745
Examiner: Mehrpour



11
TLR
10/2/00

Assistant Commissioner for Patents
Washington, D.C. 20231

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION—37 C.F.R. § 1.192)**

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on 8/2/00

NOTE: "Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. . . ." 37 C.F.R. § 1.192(a) (emphasis added).

2. STATUS OF APPLICANT

This application is on behalf of

- ☒ other than a small entity.
☐ a small entity.

A statement:

- ☐ is attached.
☐ was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.17(c), the fee for filing the Appeal Brief is:

- | | |
|---|----------|
| <input type="checkbox"/> small entity | \$150.00 |
| <input checked="" type="checkbox"/> other than a small entity | \$300.00 |

Appeal Brief fee due \$ 300.00

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CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office.

Date: 9/20/00

Signature

Elaine F. Mian
Elaine F. Mian

(type or print name of person certifying)

4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 C.F.R. § 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 C.F.R. § 1.191(d). See also Notice of November 5, 1985 (1060 O.G. 27).

NOTE: As the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the six-month maximum period specified in 35 U.S.C. § 133, the period for filing an appeal brief may be extended up to seven months. 62 Fed. Reg. 53,131, at 53,156; 1203 O.G. 63, at 84 (Oct. 10, 1997).

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 380.00	\$ 190.00
<input type="checkbox"/> three months	\$ 870.00	\$ 435.00
<input type="checkbox"/> four months	\$ 1,360.00	\$ 680.00
<input type="checkbox"/> five months	\$ 1,850.00	\$ 925.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured, and the fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$_____

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$ 300.00

Extension fee (if any) \$ _____

TOTAL FEE DUE \$ 300.00

6. FEE PAYMENT

☒ Attached is a check in the sum of \$ 300.00.

☐ Charge Account No. _____ the sum of \$ _____.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to change the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 16-1350.

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 16-1350.


SIGNATURE OF PRACTITIONER

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of: James Nicholas Seymour

Application for Patent Filed

Serial No. 08/987,995

Group Art Unit 2745

Filed 12/10/97

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APPELLANT'S BRIEF

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I. REAL PARTY IN INTEREST

The real party in interest is Nokia Mobile Phones Limited.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to the Appellant, the Appellant's legal representative or Assignee which will directly affect or which will be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 12-19, the only claims remaining in the application, have been finally rejected.

IV. STATUS OF AMENDMENTS

All pending claims are presently under rejection. The first Office Action (paper no. 4) dated August 17, 1999 rejected claims 1-11, then all of the claims in the application. On January 28, 2000, Appellant filed an Amendment, accompanied by a petition for an extension of time, to the outstanding Office Action. By the Amendment, Appellant canceled claims 1-11 and added new claims 12-19. Following this, a second, and Final Office Action was issued on March 29, 2000 (paper no. 7) rejecting all of the newly presented claims 12-19 in the application. Appellant responded with a Request for Consideration after Final Rejection filed June 27, 2000 and this was followed with an Advisory Action dated July 14, 2000. As related by the Advisory Action, the Examiner considered the arguments presented in the

Request for Consideration, but determined that it was not sufficiently convincing to overcome the final rejection.

V. SUMMARY OF THE INVENTION

The invention, as disclosed and claimed, relates to portable electronic apparatus, specifically, a portable radio telephone, provided with a sensor for sensing whether or not the telephone is coupled in intimate proximity to a rest. The rest may be a desk top, a car instrument panel top or a special stand for the telephone. As the inventive feature, the telephone has an inhibitor which inhibits operation of the telephone or locks the telephone against operation when the sensor senses that the telephone is absent from the rest.

VI. ISSUE

Whether claims 12-19 are properly rejected under 35 U.S.C. 103(a) as being as being unpatentable over Saji (US Patent Number 5,479,486) in view of French (US Patent Number 5,760,690).

VII. GROUPING OF CLAIMS

Claims 12-19 stand as a single group and rise and fall with respect to the patentability of claim 12.

VIII. PRIOR ART

- (a) The patent to French discloses a portable computer with an integrated alarm system which provides for the sounding of an alarm or for disabling the computer upon unauthorized movement of the computer from an initial stationary position. With such an arrangement, theft of the portable computer can be prevented without the need to fasten it to a surface with a mechanical device and such protection is provided by integration of the alarm system into the computer system of the very computer which is to be protected. Any detected movement of the laptop causes the triggering of French's alarm system which includes disabling the computer system of the laptop.

- (b) Saji relates to a cordless telephone set that signals an alarm if and when the respective recharging contacts between the phone and the charger are not properly coupled together. Saji does not allude to the problem of the phone being stolen; it is simply concerned with the problem of ensuring that the telephone battery is properly recharged. Thus, starting from Saji, there would be no technical motivation at all to make any modifications to Saji's phone in the area of security.

IX. ARGUMENT

It is respectfully submitted that the subject matter of the present base claim 12 of the present invention is not disclosed by the Saji patent (US Patent Number 5,479,486) in view of the French patent (US Patent Number 5,760,690) as applied under 35 U.S.C. 103(a).

As to the Sole Issue:

Claims 12-19 are rejected under 35 U.S.C.103(a) as being unpatentable over Saji (US Patent Number 5,479,486) in view of French (US Patent Number 5,760,690).

Claim 12 is an independent claim which reads as follows, in pertinent part:

“A radio telephone... coupling means for connecting to a charging unit for charging... sensing means associated with the coupling means... to sense the absence or the presence of the charging unit being connected to the radio telephone, and inhibiting means... responsive to the sensing means... such... that when the sensing means senses absence of the charging unit the inhibiting means automatically inhibits operation of the radio telephone.”

Claims 13-18 are all depended from claim 12 and, albeit further defining the claim 12 construction, include all of the limitations of claim 12. Claim 19 is a method claim defining the operation of the invention.

Comments provided by the Examiner in support of his rejection will now be considered one by one, each comment of the Examiner followed by a response by the Appellant:

Initial comment:

“Regarding Claims 12, 19, Saji teaches a radio telephone 1 including a rechargeable power supply and having coupling (b1, b2, a1, a2, 10), means for connecting to a charger unit 6 for charging the power supply, the radio telephone comprising (See figure 1): the charging apparatus is provided with setting means for detecting whether the telephone apparatus is set in the predetermined portion of the charging apparatus or not,

connection condition detecting means for detecting whether the contact of the telephone apparatus are electrically connected or not (Column 3 lines 10-14)."

Appellant's response:

If the handset of Saji is not properly positioned on the cradle of the charging apparatus, a buzzer sounds and/or an LED is illuminated although the handset would continue to be operable. If the handset of the present invention is removed from the charging unit, operation of the telephone is inhibited, that is, it is rendered inoperable.

Further comment:

"Saji fails to teach means responsive to the sensor sensing the absence of the charging unit for automatically inhibiting operation of the radio telephone. However, French teaches a portable apparatus providing alarm system, which includes various sensors for monitoring whether the system is being moved from a stationary position (Column 2 lines 62-67). Therefore unauthorized movement of the system as a whole is prevented (Column 3 lines 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users."

Appellant's response:

Indeed, it is true that "Saji fails to teach means responsive to the sensor sensing the absence of the charging unit for automatically inhibiting operation of the radio telephone". While French discloses a portable computer (not a radio telephone) with an integrated alarm system which can disable the computer upon its unauthorized movement from a stationary position, there is no teaching or suggestion that such unauthorized movement has anything whatsoever to do with its access to a charging unit.

Further comment:

“Regarding Claim 13, Saji fails to teach a radio telephone wherein the sensor and locking means are operative for a power on mode of the portable electronic apparatus. However French teaches a portable apparatus wherein more sophisticated integration may also be accomplished by coupling disable circuit 28 to the computer's system to provide the ability to send commands and data to the CPU in order to place the CPU in a locked (inoperable) mode (Column 5 lines 37-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.”

Appellant's response:

Indeed, it is true that “Saji fails to teach a radio telephone wherein the sensor and locking means are operative for a power on mode of the portable electronic apparatus”. Saji is concerned with re-charging the handset and wants the user to know if re-charging is not taking place. Nowhere in the French patent, however, is there any mention of or concern indicated that the computer may or may not be in a charging mode. While French may possibly have some “bells and whistles” broadly of the type recited in claim 13, it clearly cannot support Saji in a proper rejection of a claimed construction combining a charging unit and an inhibiting means.

Further comment:

“Regarding Claim 14, Saji fails to teach a radio telephone wherein the inhibiting means is adapted to inhibit access to information stored in the portable electronic apparatus. However French teaches a portable apparatus which is useless to a would be-thief and less likely to be stolen. With such a system the data and information stored on a computer system employing such an alarm is protected from unauthorized access by a thief (Column 2 lines 17-21). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to provide the above teaching of French to Saji, in order to provide security for the cellular users.”

Appellant's response:

Indeed, it is true that “Regarding Claim 14, Saji fails to teach a radio telephone wherein the inhibiting means is adapted to inhibit access to information stored in the portable electronic apparatus.” Nowhere in the French patent, however, is there any mention of or concern indicated that the computer may or may not be in a charging mode. Again, while French may possibly have some “bells and whistles” broadly of the type recited in claim 13, it clearly cannot support Saji in a proper rejection of a claimed construction combining a charging unit and an inhibiting means.

Further comment:

“Regarding Claims 15-16, Saji as modified by French discloses the inhibiting means. Therefore the user cannot make an outgoing call, and inhibits access to subscriber identity information stored in the memory.”

Appellant's response:

In the present invention, as claimed, the sensing means senses absence of the charging unit and the inhibiting means is responsive to the sensing means to disable operation of the radio telephone. The French patent discloses no such capability and the Saji patent discloses no such capability, nor can their combination result in such a capability.

Further comment:

“Regarding Claim 17, Saji teaches a radio telephone wherein the sensor is adapted to sense charging voltage for charging the rechargeable power supply (See figure 1 numeral 32).”

Appellant's response:

While this may be a true statement in and of itself, Saji simply does not disclose the claimed invention.

Further comment:

“Regarding Claim 18, Saji fails to teach a system wherein operation of the radio telephone is restorable responsive to a security code input to the portable electronic apparatus. However French teaches a portable system which includes a disabling circuit. Upon unauthorized tampering, the system is disabled functionally until the proper keycode is entered via a keypad interface (Column 2 lines 10-14, Column 5 lines 15-18). Therefore, it would have been obvious to ordinary skill in the art at the time the invention is made to provide the above teaching of French to Saji, in order to provide security for the cellular users.”

Appellant's response:

Indeed, it is true that “Regarding Claim 18, Saji fails to teach a system wherein operation of the radio telephone is restorable responsive to a security code input to the portable electronic apparatus.” While French discloses a disabling circuit, that disabling circuit is not in any manner related to a charging unit.

With respect to Claims 12-19 which have been rejected on combined references, it is not seen that the references can be properly combined, and

any attempt to combine them can only be made in light of the applicant's disclosure. Respectfully, the Examiner's rejection of the claims as obvious in view of a combination of Saji and French seems to be entirely misplaced.

If the skilled person wished to modify Saji's phone by adding a security feature, then assuming that he had French available to him (an unlikely assumption given that French is in the field of lap top computers) he would introduce French's motion sensor, because this is what French teaches him to do in order to combat theft of a laptop. As the Examiner has noted in the paragraph bridging pages 2 and 3 of his FINAL Office Action, the various sensors are for monitoring whether the system is being moved from a stationary position, that is, "motion sensing means for providing a motion signal" as recited in the patent. A hypothetical phone constructed through a combination of Saji and French would result in a phone with two distinct functions, both operating quite happily in their own independent ways: (1) Saji's charging alarm would still indicate when the electrical coupling was insufficient for charging (i.e. no-charge warning, and (2) French's motion sensors would sense when the phone is being moved.

One can see that even through a combination of Saji and French, the present invention -- with its clever use of the functional relationship between the sensing means, coupling means and inhibiting means -- is not reached. Furthermore, the hypothetical Saji/French phone would be an inferior solution to the one presented in the present invention as it would require additional components, have higher power consumption, be heavier, and would be prone to more failures.

In the hypothetical phone, there is no functional relationship (except, as may be learned from applicant's disclosure) between the charging alarm feature and the security alarm feature. There is nothing in either reference that would prompt or lead a skilled person to combine the functionalities, that is, there is not even a vague indication that the charging circuitry could be tapped, or that it lends itself, as a sensing means for a security feature.

In sharp contrast, the present invention harnesses a synergistic link between charging, sensing and inhibiting: that is to say the inhibiting operation of the phone is in response to the sensing means of the recharge coupling means sensing a lack of contact with the charger.

This is the insight of the present invention, an insight which leads to clear advantages. Any allegation that the present invention is obvious over Saji/French is an allegation based singularly on hindsight.

Further, consider the pertinent holding of the court in In re Sernaker, 702 F.2d 989, 994, 217 USPQ 1 (Fed. Cir. 1983). That court determined that obviousness in the context of PTO prosecution can usefully be synthesized in terms of two related inquiries: (1) "whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit;" and (2) "whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication." Thus, prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. In short, to "imbue one of ordinary skill in the art with knowledge of

the invention in suit, when no prior art reference or references or record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312 (Fed. Cir. 1983).

Applying the rationale and holdings of the Sernaker and Gore decisions to the situation at hand, it is respectfully solicited that the Examiner reconsider his determination that claims 12-19 are unpatentable over Saji (US Patent Number 5,479,486) in view of French (US Patent Number 5,760,690), finding those claims allowable, and thereby enabling a patent to issue by an early date.

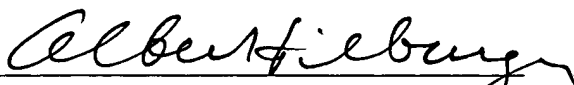
VIII CONCLUSION

The security feature claimed is simply different than the security feature of French which disables a computer upon its unauthorized movement and that there is no suggestion in Saji of disabling operation of the telephone. Rather, the alarm of Saji is not to disable operation of the telephone but to inform that the handset is not being properly charged. Suggestion of such a combination in the manner suggested by the Examiner can only come from applicant's own disclosure. Taken together, Saji and French simply do not disclose "... sensing means associated with the coupling means and operable to sense the absence or the presence of the charging unit being connected to the radio telephone, and inhibiting means configured to be responsive to the sensing means in such a manner that when the sensing means senses absence of the charging unit, the inhibiting means automatically inhibits operation of the radio telephone.

In short, the claims of the instant application define a novel and unobvious portable radio telephone provided with a sensor for sensing whether or not the telephone is coupled in intimate proximity to a rest. As the inventive feature, the telephone has an inhibitor which inhibits operation of the telephone or locks the telephone against operation when the sensor senses that the telephone is absent from the rest. A favorable determination is respectfully solicited.

A check in the amount of \$300.00 is enclosed to cover the cost of the Appeal Brief. Please charge our deposit account 16-1350 for any additional fees that might be required by this response.

Respectfully submitted,


Albert W. Hilburger, Reg. No. 20,987 9/20/00
Perman & Green Date
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Fairfield, CT 06430
203-259-1800

CERTIFICATE OF MAILING

I hereby certify that this Appellant's Brief is being deposited with the United States Postal Service today as first class mail addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231.

9/20/00
Date


Name of Person Making Deposit

APPENDIX

12. A radio telephone including a rechargeable power supply and having coupling means for connecting to a charging unit for charging the rechargeable power supply, the radio telephone comprising sensing means associated with the coupling means and operable to sense the absence or the presence of the charging unit being connected to the radio telephone, and inhibiting means configured to be responsive to the sensing means in such a manner that when the sensing means senses absence of the charging unit the inhibiting means automatically inhibits operation of the radio telephone.

13. A radio telephone according to claim 12, wherein the sensor and the inhibiting means are operative for a power on mode of the radio telephone.

14. A radio telephone according to claim 12, wherein the inhibiting means is adapted to inhibit access to information stored in the radio telephone.

15. A radio telephone according to claim 12, wherein the inhibiting mean is adapted to inhibit making an outgoing call from a radio telephone.

16. A radio telephone according to claim 12, further comprising a memory means for storing subscriber identity information, wherein the inhibiting means is adapted to inhibit access to subscriber identity information stored in the memory means.

17. A radio telephone according to claim 12, wherein the sensor is adapted to sense a charging voltage for charging the rechargeable power supply of the radio telephone.

18. A radio telephone according to claim 12, wherein operation of the radio telephone is restorable responsive to a security code input to the radio telephone.

19. A method for inhibiting unauthorized use of a radio telephone comprising the steps of sensing whether the radio telephone is coupled to a charging device and automatically inhibiting operation of the radio telephone responsive to sensing absence of the charging device.